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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,489	03/30/2001	David R. Friedman	10519/18	6544

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BRINKS HOFER GILSON & LIONE/SanDisk
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EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/823,489	FRIEDMAN ET AL.	
	Examiner	Art Unit	
	HUY T. NGUYEN	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9-14,16-26,29-34 and 36-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-14,16-26,29-34 and 36-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 December 2006 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 1,4-13,16-21,24-33,36-42, 44 –45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montoya (5,949,688) in view of Bates et al (6,74,237) and Johnson et al (6,034,882).

Regarding claims 1,21,41-42, 44-45 and 47, Montoya discloses a method for field-programming a solid-state memory device (Fig. 1) with a digital media file , the method comprising:

- (a) providing a solid-state memory device comprising a memory cells, the memory device further comprising an electrical connector coupled with the memory array (column 3 lines 1-15);
- (b) connecting the electrical connector of the memory device with an electrical connector of a digital media source;
- (c) selecting a digital media file for storage in the memory device (column 3, lines 1-12, column 4, lines 37-5) ;
- (d) field-programming the field-programmable memory cells of the memory device with the selected digital media file; and

Montoya fails to teaches selecting a file based on the user's selection .

Bates teaches an apparatus having a control means stored with predetermined information for automatically selecting a file based on the user past selection (column 2 lines 18-27).

I would have been obvious to one of ordinary skill in the art to modify Montoya with Bates by using a control mean stored with predetermined information as taught

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by Bates for automatically selecting files based on the user past selection thereby saving time and labor of a user in selecting a desired file .

Montoya fails to teaches that the solid state memory is a three-dimensional memory array of vertically-stacked field-programmable memory cells .

Johnson teaches a solid state memory comprising a three-dimensional memory array of vertically-stacked field-programmable memory cells for storing the data (column 1, lines 1-20, column 5, lines 20-40).

It would have been obvious to one of ordinary skill in the art to modify Montoya with Johnson by using a solid state memory comprising a three-dimensional memory array of vertically-stacked field-programmable memory cells as taught by Johnson as an alternative to the solid state memory of Henry for storing the media file .

Regarding claims 2,3 and 22-23, Montoya further teaches that the digital media source comprises a kiosk or is located in a retails store (Figs. 1-4, column 4, lines 15-63, column 5, lines 9-20).

Regarding claims 14 and 34, Henry as modified with Montoya further teaches charging a user of the memory device for a digital media file (See Montoya column 4, lines 15-63).

Regarding claims 4 and 24, Montoya further teaches the invention of Claim 1, wherein the digital media source is located on an end user's premises (Fig. 1).

Regarding claims 5 and 25, Montoya further teaches the digital media source comprises a digital media playback device (column 4 lines 63-68, column 5,,lines 10-15).

Regarding claims 6 and 26, Montoya further teaches the invention of Claim 1, wherein the digital media file comprises a digital media file selected from the group consisting of digital music, digital audio, digital video, at least one digital still image, a sequence of digital images, digital books, digital text, a digital map, digital data, games, software, or any combination thereof (column 1, lines 15-20).

Regarding claims 9 and 29, Montoya further comprising retrieving the selected digital media file from a storage device internal to the digital media source since the media file stored in the memory of the storage device can be selectively retrieved by the user (Fig. 1 column 3 lines 1-15) .

Regarding claims 10 and 30 Montoya further teaches retrieving the selected digital media file from a storage device external to the digital media source (column 3 line 59 to column 4 line 10).

Regarding claims 11 and 31, Montoya further teaches the invention of Claim 10, wherein the digital media source is coupled to the external storage device via a network. (column 3, lines 5-13).

Regarding claims 12 and 32, Montoya further teach the network comprises the Internet (column 3 lines 10-13, column 4, lines 63-68).

Regarding claims 14 and 34, Montoya further teaches charging a user of the memory device for a digital media file (See Montoya column 4, lines 15-63).

Regarding claims 16 and 36, Montoya further teaches the digital media playback device comprises a device selected from the group consisting of a digital audio player, a digital audio book an electronic book, a digital camera, a game player, a general-

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purpose computer, a personal digital assistant, a portable telephone, a printer, and a projector (column 4 lines 40-50, column 5 lines 10-15).

Regarding claims 17 and 37, Montoya further teaches the digital media file will only play if played from the memory device since the media file is stored in the memory device and played from the memory device (column 5, lines 10-15).

Regarding claim 18, Montoya as modified with Johnson further teaches the invention of Claim 1, wherein the memory cells comprise write-once memory cells (See Johnson column 1, lines 30-45).

Regarding claim 19, Montoya as modified with Johnson further teaches the invention of Claim 1, wherein the memory cells comprise write-many memory cells See Johnson column 1, lines 30-45).

Regarding claim 20, Montoya teaches the memory cells comprise a semiconductor (column 5, lines 10-15)

Regarding claim 38, Montoya as modified with Johnson further the memory array comprises a three dimensional memory array (Johnson, column 5, lines 30-37).

Regarding claim 39, Montoya as modified with Johnson teaches the memory array comprises a two dimensional memory array (Johnson columns 1,3).

Regarding claim 40, Montoya as modified with Johnson teaches the memory cells comprise a semiconductor material (Johnson column 1).

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4. Claims 43 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montoya in view of Johnson et al (6,034,882) and Bates et al as applied to claims 1 and 41 above further in view of Mackintosh et al (6317,784).

Regarding claims 43 and 46, Montoya as modified with Johnson fails to specifically teach the digital media file is transferred from a digital media source to the memory device via a wireless connection. However it is noted that using a wireless connection for transferring the data from a digital media source is well known in the art as taught by Mackintosh (column 5, lines 1-30). It would have been obvious to one of ordinary skill in the art to modify Montoya with Mackintosh by provide the memory device of Montoya with a wireless connection for receiving the media file thereby enhancing the capacity of the memory device of Montoya for receiving the media filed from wireless connection source.

5. Claims 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montoya in view of Johnson et al (6,034,882) and Bates et al as applied to claims 1 and 21 above further in view of Henry et al.

Montoya fails to specifically teach using a play back device for playing the recorded filed in the solid state memory .

Henry teaches a playback device having means for playback the recorded files in a solid state memory by connecting the electrical connector of the memory device with an electrical connector of a digital media playback device (See Henry, sections 0008,0035, Fig. 1).

It would have been obvious to one of ordinary skill in the art to modify Montoya with Henry by providing the apparatus of Henry with a playback device as taught by Henry for playing the recorded files in the solid state memory thereby provide more convenience to the user for reviewing the recorded when needed.

Response to Arguments

6. Applicant's arguments with respect to amended claims have been considered but are moot in view of the new ground(s) of rejection.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


HUY T. NGUYEN
PRIMARY EXAMINER